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10/661,587

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Kuo-Jung Hsu

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EXAMINER

SHERMAN, STEPHEN G

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/661,587

**Applicant(s)**

HSU, KUO-JUNG

**Examiner**

Stephen G. Sherman

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This office action is in response to the amendment filed the 21 May 2007.

Claims 1 and 4-17 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 21 May 2007 with respect to claims 1 and 4-16 have been fully considered but they are not persuasive.

The applicant states on page 6 of the response that Kawa et al. has a housing that comprises only an external surface but no identifier disposed thereon surrounding the receiving portion, and therefore Kawa et al. do not teach the limitation as amended in claim 1. The examiner respectfully disagrees. As explained in the rejection of claim 1 below, Kawa et al. disclose in Drawing 1 and paragraph [0029] that the housing further includes a concave or convex Braille points 20a on the external surface that surround the surface corresponding to the receiving portion, i.e. this means there is an identifier on the external housing. Therefore Kawa et al. anticipate the claim.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: the claim states: "an identifier disposed on the external surface, identifier surround a surface..." the

examiner believes the claim should recite: "an identifier disposed on the external surface, the identifier surround a surface...". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Kawa et al. (JP 2002-297309).

***Regarding claim 1***, Kawa et al. disclose a notebook computer with a hidden touch pad (Drawing 1), comprising:

a main portion including a housing portion (Drawing 1 shows body 2 which is a housing portion.),

wherein the housing portion further includes an external surface (Drawing 1),  
an internal surface having an receiving portion (Drawing 3b and paragraph [0023] explain that the body 2 has the surface shown as item 54 in the drawing, and that this internal side has a portion for receiving the touch pad.), and

an identifier disposed on the external surface (Drawing 1 shows 20a and paragraph [0029] explains that the housing further includes a concave or convex Braille

Art Unit: 2629

points on the external surface that surround the surface corresponding to the receiving portion, i.e. there is an identifier on the external housing.),

identifier surrounding a surface corresponding to the receiving portion (Drawing 1 and paragraph [0029] explain that the identifier 20a surrounds where the touch pad 20 is located on the internal surface, i.e. the receiving portion.)

a display connected to the main portion in a rotatable manner (Drawing 1 shows display section 3); and

a touch pad disposed onto the receiving portion (Drawing 3b shows that touchpad portion 53 is received by the body 2.);

wherein the receiving portion of the internal surface prevents the touch pad from being exposed to an atmosphere outside of the housing portion (Paragraph [0024]).

**Regarding claim 4**, Kawa et al. disclose the notebook computer as claimed in claim 1, wherein the receiving portion has a concave portion (Paragraph [0025] states that the material where the track pad 53 is located should be made to be thin, which means that if that it is thin and the rest of the surface is thicker, then this portion will be concave.).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Kawa et al. (JP 2002-297309).

**Regarding claim 7**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the thickness of the receiving portion is about 0.5-0.8mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the thickness of the receiving portion between .5-.8 mm since a notebook computer is portable and it is important to have the overall size of the notebook computer be relatively small meaning that all the components located inside of the computer would also need to be small.

**Regarding claim 8**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing is about 0.7-1.0 mm.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the difference between the thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 0.7-1.0 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

**Regarding claim 9**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer wherein a ratio between the thickness of the receiving portion and the thickness a portion, adjacent to the receiving portion, of the housing is about 1/3-1/2.

However, since it is not shown in the specification how this specific range proves to be beneficial to the overall device, it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to make the ratio between the

thickness of the receiving portion and that of a portion, adjacent to the receiving portion, of the housing to be about 1/3-1/2 mm because it is important for the housing to keep a relatively small size but still be thicker than other components in the computer such that the internal components are protected properly.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Garner (US 6,501,462).

**Regarding claim 17**, Kawa et al. disclose the notebook computer as claimed in claim 2.

Kawa et al. fail to teach that the identifier is a flange surrounding the receiving portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by Kawa et al. in order to provide improved tactile feedback such that the touchpad can be found without looking for it with the eye.

10. Claims 5-6 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Keely, JR. et al. (US 2002/0063694).

**Regarding claim 5**, Kawa et al. disclose the notebook computer as claimed in claim 1.

Kawa et al. fail to teach of the notebook computer further comprising: an adhesive member adhering the touch pad to the receiving portion.

Keely, JR. et al. disclose of a notebook computer further comprising: an adhesive member adhering a touch pad to the outer surface opening (Paragraph [0041]).

Therefore it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to adhere the touch pad using adhesive as taught by Keely, JR. et al. to the outer edges of the receiving portion of the notebook computer taught by Kawa et al. in order to provide the desired stiffness, producing permanent alignment, shock control, the spread of impact forces along the edges, and liquid seal, with minimum cost, weight, and number of parts.

**Regarding claim 6**, Kawa et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 5.

Keely, JR. et al. also discloses wherein the touch pad is closely adjacent to the outer surface opening via the adhesive member, thereby eliminating any gap between the outer surface opening and the touch pad (Paragraph [0041]. The examiner

Art Unit: 2629

interprets that when anything is sealed with an adhesive such that liquids are prevented from entering that the gap between the two items is eliminated.).

**Regarding claim 10**, this claim is rejected under the same rationale as claims 1 and 5.

**Regarding claim 11**, this claim is rejected under the same rationale as claims 5 and 6.

**Regarding claim 12**, this claim is rejected under the same rationale as claim 7.

**Regarding claim 13**, this claim is rejected under the same rationale as claim 8.

**Regarding claim 14**, this claim is rejected under the same rationale as claim 9.

**Regarding claim 15**, Kawa et al. and Keely, JR. et al. disclose the method as claimed in claim 10.

Kawa et al. and Keely, JR. et al. fail to teach of the method wherein the housing is formed by injection molding.

However, it would have been obvious to “one of ordinary skill” in the art at the time the invention was made to form the housing using injection molding since it is well

known that the injection molding process has high production rates, allows design flexibility, has relatively low labor, and has minimum scrap losses.

**Regarding claim 16**, this claim is rejected under the same rationale as claim 4.

11. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawa et al. (JP 2002-297309) in view of Keely, JR. et al. (US 2002/0063694) and further in view of Garner (US 6,501,462).

**Regarding claim 18**, Kawa et al. and Keely, JR. et al. disclose the notebook computer as claimed in claim 10.

Kawa et al. and Keely, JR. et al. fail to teach that the identifier is a flange surrounding the receiving portion.

Garner discloses of a notebook computer wherein the housing further includes a flange on the external surface, and the flange surrounds the surface correspond to the receiving portion (Figure 1, item 39 and column 4, lines 5-12. The examiner interprets that item 39 is a flange which surround the touch pad portion item 35.).

Therefore it would have been obvious to "one of ordinary skill" in the art at the time the invention was made to use the flange taught by Garner with the notebook computer taught by the combination of Kawa et al. and Keely, JR. et al. in order to provide improved tactile feedback such that the touchpad can be found without looking for it with the eye.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen G. Sherman whose telephone number is (571) 272-2941. The examiner can normally be reached on M-F, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

14 June 2007

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